

## REMARKS

Applicant requests that this paper be entered into the record as being responsive to the Examiner's Office Action dated 05/05/2006. No claims have been amended.

### **Rejections based upon 35 USC 103.**

Claims 1, 3, 5, and 8 stand rejected over Jury et al. (US 6,262,175) in view of Marinelli (US 6,247,651).

Combining the teachings of the Jury et al. reference with the Marinelli reference is improper. The Marinelli reference teaches a composite crosstie made with 65% polyethylene and polypropylene plastics and 15% waste glass fiber (Marinelli Col. 2, lines 22-25). Thus, 80% of the make-up of a crosstie made according to Marinelli is not even part of the claimed crosstie. Marinelli, or the combination of the Marinelli and Jury et al. references is improper since it is not obvious that Applicant's invention can be made from the teachings of these references.

Further, Marinelli teaches the use of 15% by weight screener waste glass *fibers* (Marinelli Col. 2, line 25). By contrast, Jury et al. states: "Since the compositions of the invention are preferably *fiber-free*, all fibrous material such as tire cord fibers is preferably likewise removed from the ground rubber using conventional separation procedures before use in the compositions of the invention." (Jury et al., Col. 2, lines 17-22).

There must be some suggestion or motivation, to modify or combine reference teachings. (MPEP §2143.01). Since the Marinelli reference teaches 15% fibrous material and Jury et al. teaches fiber-free, there is clearly no motivation to combine these references.

Even where the combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir 1998). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).



Thus, the Examiner's position that "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jury et al. to include the use of his advantageous rubber product in a crosstie application as taught by Marinelli..." is incorrect.

While Marinelli requires a crosstie to include glass fibers, the Jury et al. disclosure specifically teaches away from the use of such fibers in its thermoplastic composition. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference. If when combined, the references "would produce a seemingly inoperative device", then they teach away from their combination. *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353; 52 USPQ 1294, 1298 (Fed. Cir. 1999).

For the reasons so stated above, claims 1, 3, 5 and 8 are believed to be in a condition for allowance as well as pending dependent claims 2, 4, 6, 7 and 9.

### **CONCLUSION**

All pending claims are believed to be in a condition for allowance.

Respectfully submitted,

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